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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/001,490	10/31/2001	Stanley J. Kopecky	112703-206	3231
29156	7590	10/09/2003	EXAMINER	
BELL, BOYD & LLOYD LLC P. O. BOX 1135 CHICAGO, IL 60690-1135			PICKETT, JOHN G	
			ART UNIT	PAPER NUMBER
			3728	
DATE MAILED: 10/09/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/001,490

Applicant(s)

KOPECKY, STANLEY J.

Examiner

Greg Pickett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 28 July 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. This Office action acknowledges the applicant's Amendment A, presented as Paper No. 7. Claims 1-22 are pending in the application.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Drawings

3. The proposed drawing changes were received on July 28, 2003. These drawings are acceptable.

Claim Rejections - 35 USC § 103

4. Claims 1-8, 10-16, and 18-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ranney (US 2,380,367) in view of Hachenski (US 6,138,905) and Howes (US 5,896,686).

Regarding claim 1, Ranney discloses a gum package (Figure 1) having a body (16) with a removable end wall (16'). The removable end wall (16') has an inner surface, the entirety of which is only visible when the end is removed. Ranney meets all limitations claimed by the applicant except for giveaway information visible by viewing the inner surface.

Hachenski discloses a container with printed matter on the inner surface of its lid. Howes discloses providing giveaway information on the inside of a removable lid and

immediately visible when the lid is removed. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the gum package of Ranney with giveaway information on the inner surface of the removable lid as taught by Hachenski and Howes in order to provide the consumer with an incentive to buy the product.

As to claim 2, the gum package of Ranney is rectangular in shape.

As to claim 3, the gum package of Ranney discloses tab and ribbon (21, as shown, Figure 1).

As to claim 4, the gum package of Ranney is constructed in part from a flexible foil.

As to claim 5, Howes discloses giveaway information adapted to inform the consumer whether or not they have won a prize.

As to claim 6, Howes discloses giveaway information concerning a contest.

As to claim 7, Hachenski discloses information printed on the inner surface.

As to claim 8, Hachenski discloses information printed on the inner surface, Hachenski does not expressly disclose stamping information on the inner surface. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the giveaway information on the inner surface of the end wall of the gum package of Ranney-Hachenski-Howes by stamping since the examiner takes Official notice of the equivalence of stamping and printing for their use in the information providing art and the selection of any of these known equivalents to provide giveaway information would be within the level of ordinary skill in the art.

As to claim 10, the gum package of Ranney houses a plurality of sticks of chewing gum.

Regarding claim 11, Ranney discloses a package (Figure 1) having a flexible body (16) with inner surfaces defining an interior for housing products and a removable end wall (16'). The removable end wall (16') has an inner surface, the entirety of which is only visible when the end is removed. The removable end wall (16') is removable by grasping and pulling member (21). Ranney meets all limitations claimed by the applicant except for giveaway information visible by viewing the inner surface.

Hachenski discloses a container with printed matter on the inner surface of its lid. Howes discloses providing giveaway information on the inside of a removable lid and immediately visible when the lid is removed. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the gum package of Ranney with giveaway information on the inner surface of the removable lid as taught by Hachenski and Howes in order to provide the consumer with an incentive to buy the product.

As to claim 12, member (21) of Ranney is a tab.

As to claim 13, Ranney discloses grasping a tab and tearing a portion of the body to remove the end wall.

As to claim 14, Hachenski discloses information printed on the inner surface.

As to claim 15, the package of Ranney is constructed in part from a flexible foil.

As to claim 16, the package of Ranney is rectangular in shape.

Regarding claim 18, the gum package of Ranney-Hachenski-Howes discloses the claimed method by presentation.

As to claim 19, the package of Ranney-Hachenski-Howes provides a tab for tearing the package to remove the end wall.

As to claim 20, the package of Ranney-Hachenski-Howes discloses providing printing on the inner surface.

As to claim 21, the package of Ranney-Hachenski-Howes discloses providing printing on the inner surface. Ranney-Hachenski-Howes does not expressly disclose stamping information on the inner surface. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the giveaway information on the inner surface of the end wall of the gum package of Ranney-Hachenski-Howes by stamping since the examiner takes Official notice of the equivalence of stamping and printing for their use in the information providing art and the selection of any of these known equivalents to provide giveaway information would be within the level of ordinary skill in the art.

As to claim 22, the package of Ranney-Hachenski-Howes is rectangular in shape.

5. Claims 9 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ranney in view of Hachenski and Howes as applied to claims 9 and 11 above, and further in view of Focke et al (US 5,375,704).

Regarding claim 9, the gum package of Ranney-Hachenski-Howes as applied to claim 1 above meets all limitations claimed by the applicant except for giveaway information provided on a removable insert.

Focke et al discloses a package (12) with giveaway information provided on a removable insert (28). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the package of Ranney-Hachenski-Howes with a removable insert as taught by Focke et al in order to limit the production requirements of the consumer to claim their prize (i.e., it would only be necessary for the consumer to provide the insert to claim the prize).

Regarding claim 17, the package of Ranney-Hachenski-Howes as applied to claim 11 above meets all limitations claimed by the applicant except for giveaway information provided on a removable insert.

Focke et al discloses a package (12) with giveaway information provided on a removable insert (28). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the package of Ranney-Hachenski-Howes with a removable insert as taught by Focke et al in order to limit the production requirements of the consumer to claim their prize (i.e., it would only be necessary for the consumer to provide the insert to claim the prize).

Response to Arguments

6. Applicant's arguments filed July 28, 2003 have been fully considered but they are not persuasive.

7. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

8. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the long term storage of the articles contained and the immediate redemption of the prize) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

9. In response to the applicant's argument that the Howes reference does not allow for the immediate viewing of the information, this assertion is incorrect. Item 22 of the Howes reference is not a cover, but a lens. As shown in figures 3, 4, and 7-9, the indicia on the inner surface is immediately visible upon removal of the cover. Whether the indicium is giveaway information is deemed an intended use.

10. In response to the applicant's arguments with respect to Hachenski, the examiner never modified the package of Hachenski. Hachenski was used as a bridging

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reference between the box-like package of Ranney and the bottle package of Howes. Hachenski shows that it was known in the art to place indicia on the interior lid surface of a box-like packaging structure.

11. In response to the applicant's arguments with respect to Focke et al, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Focke et al teaches removable printed information under the lid of a package. Further, it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

12. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

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13. In response to applicant's argument that Howes is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Howes is pertinent to the provision of an incentive for a purchaser to purchase a specific product.

14. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation can be found in the prior art of record, specifically, in Howes, Col. 1, ll. 11-16.

Conclusion


THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

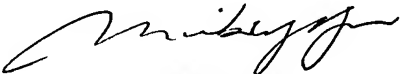
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greg Pickett whose telephone number is 703-305-8321. The examiner can normally be reached on Mon-Fri, 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.


Gregory Pickett
Examiner
October 2, 2003


Mickey Yu
Supervisory Patent Examiner
Group 3700